

REMARKS

Claims 35-49 are pending in this application, of which claims 35 and 41 are independent. Applicants propose to amend claim 35, cancel claims 38 and 39 and add new claims 50-53. These amendments and new claims do not create new issue. Entry of the same is respectfully solicited. For the following reasons, it is submitted that this application stands in condition for allowance.

New claims

Claim 35 has been amended by incorporating the subject matter of dependent claim 38. Claims 38 and 39 have been cancelled. Furthermore, new claims 50-53 have been added and correspond to claims 35 (incorporating the subject matter of cancelled claim 39), 36, 37 and 40, respectively. Because these amendments and new claims merely place the claims in presumably an allowable form by incorporating dependent claims already considered, no more than a cursory review by the Examiner is required. It is respectfully solicited that these amendments and new claims are entered.

Claim rejection and objections

The Examiner maintains the rejection of claims 35-39 under 35 U.S.C. § 103(a) as being unpatentable over Zedalis in view of Weaver. Claim 40 stands objected to as being dependent upon a rejected base claim, but would otherwise be allowed. It is acknowledged with appreciation that claims 41-49 stand allowed. The claim rejection is respectfully traversed.

The Examiner further indicates that Applicants' response of September 22, 2003, has been carefully considered and alleges that Applicants attempted to overcome the prior art rejection by amending the claims to read outside of the prior art range. The Examiner

further indicates that the claimed range, as amended, could still be considered obvious. Notwithstanding, Applicants amended claim 35 to recite a temperature range from 600°C to 900°C for clarity (previously reciting a temperature range of 600°C and above), further recognizing that Weaver fails to disclose the claimed temperature and Zedalis merely “touches” the lower end of the claimed temperature range.

The Examiner indicates further that support to the higher range limit must be “literally supported by the specification,” though he did not specifically address inadequate support under any type of rejection. Support was clearly indicated to be found in the specification in, for example, Table 2. Support is presumed to be adequate.

While the Examiner seems to have been responsive to the amendments made in Applicants’ previous response, the Examiner has not addressed the inadequacies of the motivation to combine previously pointed out by Applicants. It is further noted that the Examiner reiterates the same motivation to combine the references, found on page 3 of the Office Action. There, the Examiner states that “it would have been obvious to one having ordinary skill in the art at the time of the invention to use nitrogen atmosphere of Weaver in the invention of Zedalis et al. in order to provide a non-oxidizing atmosphere.” This motivation is basically flawed and has yet to be cured. Please consider the legal tenets and analysis set forth below.

In addition to identifying claim elements, the Examiner is charged with the initial burden of providing the realistic requisite motivation for combining applied references to arrive at the claimed invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical System. v. Vital Signs*, 183 F.3d 137 (Fed. Cir. 1999). The Examiner’s assertion that use of a nitrogen atmosphere of Weaver in Zedalis

would have been obvious “in order to provide for a non-oxidizing atmosphere” does not provide any positive suggestion for the proposed combination, nor does the Examiner’s assertion provide any specific benefit resulting from the proposed combination. Moreover, the alleged motivation seems to be predicated on the fact that it would have been “well known” to apply a non-oxidizing atmosphere during sintering because the combination of references teaches the claimed elements. Such rationale is legally impermissible. In fact, it has been held that even if prior art could have been modified so as to result in the combination defined by the claims, the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986). The fact that a non-oxidizing atmosphere could be used with the process described by Zedalis does not, as a matter of fact, make the combination obvious. The Examiner has provided no showing in the prior art of a suggestion of the desirability to modify. Because the Examiner has failed to provide any prior art suggestion for the modification of Zedalis, the basis of the rejection is no more than inappropriate hindsight reconstruction using Applicants’ claim as a guide. *In re Warner*, 379 F.2d 1011 (CCPA 1967). The Examiner has not met the initial burden of providing realistic requisite motivation, thus rendering the obviousness rejection improper.

Notwithstanding these inadequacies, claim 35 has been amended by incorporating the subject matter of claim 38. New claim 50 has been added which corresponds to the subject matter of unamended claim 35 and cancelled claim 39. Accordingly, claim 35 requires that the sintering step is conducted in an atmosphere having an oxygen concentration of 200ppm or lower. Claim 50 requires that the sintering step is conducted in an atmosphere having a dew point of -20°C or lower. These limitations are neither disclosed

nor suggested by Weaver, Zedalis or the combination thereof. Although Weaver discloses use of O₂ free gas (see col. 3, lines 49-54) and nitrogen gas (see col. 4, lines 53-54), there is no description about prescribing any amounts of these gases. Further, there is no disclosure or suggestion of a dew point for the atmosphere. Applicants have thoroughly reviewed Zedalis, and similarly find no disclosure or suggestion of an atmosphere oxygen concentration or an atmosphere dew point, as is recited by amended claims 35 and new claim 50.

It is further noted that the Examiner has not addressed the limitations recited by original claims 38 and 39, i.e., atmosphere oxygen concentration or dew point. In order for the Examiner to establish requisite burden of proof, the Examiner must address each and every limitation recited by the claims. The Examiner has failed to do so.

It is submitted that the Examiner has not met the initial burden of proof for establishing motivation to combine and for addressing each claim under rejection. Notwithstanding, claim 35 and new claim 50 recite limitations which neither Weaver nor Zedalis discloses or suggests.

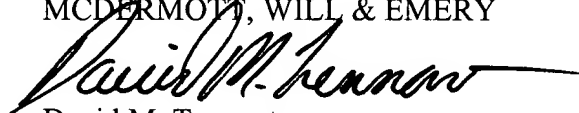
For the above reasons, this rejection has been presumably overcome. If the Examiner has any comments or questions concerning this response or the application in general, the Examiner is encouraged to contact the undersigned in order to expedite prosecution of this case.

08/683,275

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read "David M. Tennant", written over the printed name.

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